

Pursuant to the Office Action issued on September 7, 2001, claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,821,515 to Kitahara ("Kitahara") and United States Patent No. 5,530,232 to Taylor ("Taylor"). By the foregoing amendment, the Applicant has amendment independent claims 1, 13, and 23 and dependent claims 9, 10, 12, and 15. Applicant has cancelled claims 4 and 14. Claims 1-3, 5-13, and 15-23 remain pending. In light of the aforementioned amendment and the remarks stated herein, the Applicant respectfully traverses the rejection of claims 1-3, 5-13, and 15-23 under 35 U.S.C. 103(a).

#### Rejection Under 35 U.S.C. 103

The Applicant has hereby amended independent claims 1, 13, and 23, to include language specifically directed to systems and methods usable with each of three separate memories. None of the cited references disclose systems and methods capable of reading from or writing to three separate memories.

Referring to the Examiner's primary reference, Kitahara, there is no embodiment disclosed in this reference that described reading from and/or writing to three separate memories. The Examiner is correct in pointing out that Kitahara does disclose an alternative embodiment wherein a magnetic memory could replace an optical memory on a hybrid card, such that the magnetic memory resides on the card with an IC memory, Kitahara does not suggest that all three memories be resident on the card at the same time or that a single reader include three components for reading three separate memories. At most, Kitahara describes two memories on a card and a reader capable of reading the two memories. In fact, it is arguable that Kitahara

teaches away from having three memories on a single card, since Kitahara requires replacement of the optical memory with a magnetic memory, as opposed to addition thereto.

The Examiner's secondary reference, Taylor, also fails to describe reading from and/or writing to three separate memories. Taylor refers only to dual memory cards. There are no embodiments nor any suggestion for tri-memory cards. As such, there is no suggestion for a reader that includes components for reading three separate memories.

Finally, the art cited in the Examiner's conclusion also fails to disclose or suggest a card having three separate memories or a reader for reading from or writing to three separate memories on a single card. Consequently, the Examiner's assertion that it would have been obvious to one of ordinary skill in the art to provide a third memory means in addition to the first and second memory of the card described in Kitahara is not suggested or supported by any of the cited references.

In order to establish a *prima facie* case of unpatentability under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In this case, there is no reference that describes either (1) a card including three separate memories or (2) a card reader that includes components for reading three separate

memories. Consequently, the third criteria for establishing a *prima facie* case of unpatentability under 35 U.S.C. § 103(a) has not been met.

In the event that the Examiner attempts to argue that the third criteria is met through the taking Official Notice with respect to limitations (1) and (2), the Applicant wishes to point out that unlike factual arguments for unpatentability made by an Examiner based on references or even case law, when an Examiner takes Official Notice, this does not constitute the necessary factual basis for supporting a *prima facie* case of unpatentability. The Supreme Court in Graham v. John Deere Co. placed the “burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103.” 383 U.S. 1, 148 USPQ 459, 15 L.Ed. 2d 545, 86 S.Ct. 684 (1966). Takings of Official Notice without more are merely subjective statements made by the Examiner. Consequently, these statements alone do not initially rise to the level of establishing a *prima facie* case of unpatentability such that rebuttal argument or evidence is necessary to overcome the rejection.

As required by In re Chevenard, the Applicant hereby seasonably challenges the Examiner’s taking of Official Notice and requests that the Examiner provide objective evidence in order to establish a *prima facie* case of unpatentability. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Applicant respectfully assert that the claims as presented herein are patentable over the references cited by the Examiner.

CONCLUSION

The Applicant respectfully submits that the claims presented herein are in condition for allowance in view of the cited prior art and earnestly request a notice of allowance to that effect. Should there be any further issues regarding prosecution of this case, please do not hesitate to contact the undersigned at the number provided below.

Respectfully submitted,

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**Marked-up Version of the Claims Showing Amendments**

1. (Amended) A method for controlling the reading from and writing to a multi-memory card comprising:

positioning a first memory of the multi-memory card within a first read/write component to facilitate reading from the first read/write component;

reading information from the first memory;

providing selectable functions in the form of a menu to a user;

receiving a first selected function, the first selected function having an associated second read/write component;

transporting the multi-memory card to the second read/write component according to the first selected function;

positioning a second memory of the multi-memory card within the second read/write component to facilitate reading from and writing to a second read/write component; and

performing the first selected function;

displaying the results of the first selected function to the user;

providing selectable functions to the user;

receiving a second selected function, the second selected function having an associated third read/write component;

transporting the multi-memory card to the third read/write component according to the second selected function;

positioning a third memory of the multi-memory card within the third read/write component to facilitate reading from or writing thereto according to the second selected function; and

reading from or writing to the third memory according to the second selected function.

Please cancel claim 4.

9. (Amended) The method according to claim 1 [4], wherein the third read/write component is selected from the group consisting of a magnetic read/write component, an electronic read/write component, and an optical read/write component.

10. (Amended) The method according to claim 1 [4], wherein the third memory is selected from the group consisting of a magnetic memory, an electronic memory, and an optical memory.

12. (Amended) The method according to claim 1 [4], wherein the second selected function is selected from the group consisting of:

- resetting at least one of the first and second memories;
- reviewing account balances in at least one of the first and second memories;
- reconciling accounts based on information in at least one of the first and second memories;
- updating account information in at least one the first and second memories;
- transferring money to or between at least one of the first and second memories; and
- dispensing the multi-memory card.

13. (Amended) A system for controlling the reading from and writing to a multi-memory card comprising:

- a read/write device including a magnetic read/write component, an optical read/write component, and an electronic read/write component for reading from or writing to a magnetic memory, an optical memory and an electronic memory of the multi-memory card;

- a transport device connected to the read/write device for transporting the multi-memory card within the read/write device; and

a control device operatively coupled to the transport device and the read/write device for controlling the transport device and the read/write device.

Please cancel claim 14.

15. (Amended) A system according to claim 13 [14], wherein the transport device comprises at least two transport mechanisms selected from the group consisting of a magnetic transport mechanism, an optical transport mechanism, and an electronic transport mechanism for transporting the multi-memory card through the magnetic read/write component, optical read/write component and the electronic read/write component.

23. (Amended) A system for controlling the reading from and writing to a multi-memory card comprising:

- means for positioning a first memory of the multi-memory card within a first read/write component to facilitate reading from the first read/write component;

- means for reading information from the first memory;

- means for providing selectable functions in the form of a menu to a user;

- means for receiving a first selected function, the first selected function having an associated second read/write component;

- means for transporting the multi-memory card to the second read/write component according to the first selected function;

- means for positioning a second memory of the multi-memory card within the second read/write component to facilitate reading from and writing to a second read/write component; and

- means for performing the first selected function;

- means for displaying the results of the first selected function to the user;

- means for providing selectable functions to the user;

means for receiving a second selected function, the second selected function having an associated third read/write component;

means for transporting the multi-memory card to the third read/write component according to the second selected function;

means for positioning a third memory of the multi-memory card within the third read/write component to facilitate reading from or writing thereto according to the second selected function; and

means for reading from or writing to the third memory according to the second selected function.